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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/039,547 | 11/09/2001 | Philip N. Garfinkle | 81934EF-P | 5850 |

7590 01/29/2003

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| EXAMINER |
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MATHEWS, ALAN A

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| ART UNIT | PAPER NUMBER |
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2851

DATE MAILED: 01/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|-------------------------------|----------------------------------|--|
| Office Action Summary | Application No. 10/039,547 | Applicant(s) GARFINKLE ET AL. | |
| | Examiner Alan A. Mathews | Art Unit 2851 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>2</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. Claim 6 is objected to in that on line 2, the term "store" should be "stored". Appropriate correction is required.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-33 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-38 of U.S. Patent No. 6,017,157. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-33 of the instant application are obvious modifications of claims 1-38 of U. S. Patent No. 6,017,157.

4. Claims 1-33 rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-29 of U.S. Patent No. 6,133,985. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-33 of the instant application are obvious modifications of claims 1-29 of U. S. Patent No. 6,133,985.

5. Claims 1-33 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 55-100 of copending Application No. 09/490,341 (which, according to PALM, will issue as U. S. Patent No. 6,512,570 soon after this office action is mailed). Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-33 of the instant application are obvious modifications of claims 55-100 of copending Application No. 09/490,341.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

6. Claims 1-33 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 41-53,55-65,67-99,101-115,117 and 119-131 of copending Application No. 09/490,346. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-33 of the

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instant application are obvious modifications of claims 41-53,55-65,67-99,101-115,117 and 119-131 of copending Application No. 09/490,346.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

7. Claims 1-33 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-44 of copending Application No. ~~10/039,546~~ ^{10/037,810}. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-33 of the instant application are obvious modifications of claims 1-44 of copending Application No. ~~10/039,546~~ ^{10/037,810}.

AM
SEE
interview
summary
(paper #4)
3-31-03

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

9. Claims 1-33 are rejected under 35 U.S.C. 102(e) as being anticipated by Haneda (U. S. Patent No. 6,243,171). Haneda discloses in figures 1, 27, and 32 a film scanner 12 or 12A which converts a film image into a digital image. The original digital image is assigned an image identification number for each frame (see column 5, lines 23-27). Column 15, line 10-47, discloses providing an identification code specific to the film. Column 15, lines 14-17 specifically states:

The identification code basically is for identifying the film but preferably should be capable of clearly indicating which laboratory (or dealer) and which laboratory system processed the film.

Column 17, lines 57-62 states that a communication unit 19 communicates with a user and the user's playback machine P1 via a telephone line T1. The user playback machine P1 (a remote computer), can be used to transmit an order. Column 17, lines 63-67, and column 18, lines 1-4 states that a **management center acts as a relay station. A plurality of laboratory systems are connected to the management center via leased line or public telephone line, and the playback machines are connected to the laboratory system via the management center.** The management center would inherently have a server. The plurality of laboratories would have a plurality of image servers (see column 31, lines 44-67, and column 32, lines 1-22). Column 32, lines 48-50 disclose that the user playback machine may be connected to the Internet. Figure 47 illustrates the electrical configuration of the playback machine utilized by the user. Column 43, lines 16-21 discloses that communication unit 89 of the user playback machine can be used for ordering extra prints, and also **function to receive resources sent from the laboratory system**

or from some other computer system. In this case, it is no longer necessary to store the resources on the user's disk. The resources can include a video component.

10. Claims 1-33 are rejected under 35 U.S.C. 102(e) as being anticipated by Dellert et al. (U. S. Patent No. 5,760,916). Dellert et al. Dellert et al. discloses in figure 1 a central image server 20 where digital images can be stored. Figure 2 and column 8, lines 6-23, disclose assigning an identification 60 to the digital image and sending the ID to the customer. The ID can be encrypted (see column 5, lines 44-64). The ID and the encryption are considered to be access codes. The user would access the images at remote terminals 40A, 40B etc. Figure 4 and column 4, lines 54-67, and column 5, lines 1-38, disclose the use of a plurality of hubs (for example, hub 20 and hub 21). Each of the hubs has a server (thus providing the overall system with a plurality of servers). The user could, for example, connect with hub 21 through hub 20 from a remote terminal 40A. The hub 20 would accept an order for more prints (goods and/or services) and then transfer this order to hub 20 (see column 11, lines 23-38). Column 6, lines 11, and column 7, line 6, discloses the use of the Internet as the network.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 1-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shaffer et al. (U. S. Patent No. 5,784,461) in view of Haneda (U. S. Patent No. 6,243,171). Shaffer et al. discloses in figure 1 a photofinisher 10 with a computer 20 which appends a unique ID and a security key to the images and storage of the images (see column 3, lines 19-31). A customer site 14 can send an order for goods and/or services to a server in the fulfillment center 12 by way of a communication link 36, such as a telephone line or Internet (see column 3, lines 41-54). Thus, Shaffer et al. discloses the invention claimed except for specifically stating that the photofinisher 10 has a server and providing a plurality of image servers (although it might be argued that computer 20 is an image server). Haneda discloses in figure 32 and column 31, line 45, providing servers in the laboratory. Haneda further discloses in column 17, line 57-67, and column 18, lines 1-4, a management center acting as a relay station. A plurality of laboratory systems are connected to the management center via leased line or public telephone line, and the playback machines are connected to the laboratory system via the management center. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to provide the photofinisher 10 (which is a laboratory) with a server and to provide Shaffer et al. with a plurality of photofinishers or laboratories (servers) in view of Haneda for the purpose of providing quick and easy communication between the photofinisher and the fulfillment center, thus providing convenience to the customer and increased flexibility for the laboratories and/or vendors.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The patents on Applicant's PTO 1449 are cited for the same reasons Applicant cited them in his INFORMATION DISCLOSURE STATEMENT and for the same reasons they were cited in the parent applications. The patent to Maghadam et al. is cited to show a network and remote computers in figure 9. The patent to Thevdos et al. is cited to show previewing video segments from remote computers (see figures 1-3) and multiple layers of servers. The patent to Kitamoto is cited to show a print management system. The patent to Maurinus et al. is cited to show the use of digital capture stations 14 and digital cameras 16 and networks to manage images and prints. The British patent is cited to show accessing stored images by telephone line 54 in figure 2. The patents to Fredlund et al., Dreeste et al., and Allen are cited for the same reasons they were cited in the parent applications and related applications.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alan A. Mathews whose telephone number is (703) 308-1706. The examiner can normally be reached on Monday through Friday from 8:00 AM to 4:30 PM.

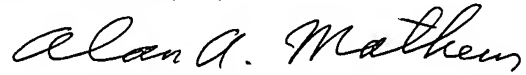
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Russ Adams can be reached on (703) 308-2847. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9318 for regular communications and (703) 872-9319 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

A handwritten signature in cursive script that reads "Alan A. Mathews".

Alan A. Mathews
Primary Examiner
Art Unit 2851

AAM
January 24, 2003